

claims 6-8 have not previously been examined, entry and allowance of these claims is requested for reasons set forth below.

Briefly, the present invention is directed to an improved external storage device, and particularly an external storage device which permits a host computer to provide protection for a specified area of the user data area. As described on pages 1 and 2 in the background of the invention, in typical prior external storage devices utilized with a host computer, all of the user data areas are either protected or not protected. As a result, ease of the use of the external storage device can be degraded if protection is desired since all of the user data areas must then be protected.

In the present invention, as shown in Fig. 3 (cited solely for purposes of example), a user data area 171 is divided into a normal area 1711 and a protected area 1712. As discussed on page 3, line 2 et seq., different commands are used for reading, writing and erasing the normal area of user data and the protected area of user data by the host computer. As such, it is possible using the present system for the access to the protected area of user data to be limited to use of a password, without also requiring a password to access the normal area of user data.

In addition, with the present invention, it is possible for the host computer to dynamically change the sizes of the protected area and the normal area, as discussed on page 3, line 22 et seq. As such, an external storage device is provided which is much more convenient to use and much more versatile than prior systems.

Turning to the Office Action, at the outset, consideration of the two Japanese documents 7-175725 and 8-272925 submitted with the May 3, 2001 Information Disclosure Statement is respectfully requested (it is presumed that the document mentioned in paragraph 2 of the Office Action as 7-175727 was, in fact, JP7-175725,

as listed on the International Search Report and the Form PTO-1449 provided with the May 3, 2001 Office Action). In paragraph 2 on page of the Office Action, it was indicated that these documents were not considered since the statement:

“fails to comply with 35 C.F.R. 1.98(a) and (3) because it does not include a concise explanation of relevance. . . . of each patent listed that is not in the English language.”

In response to this, applicants respectfully submit that the concise explanation of relevance for these two documents was provided by the English language version of the International Search Report filed with the IDS on May 3, 2001. For these two documents, the International Search Report indicated that relevance of each of these documents was category “Y” which is defined in the International Search Report.

This statement of relevance, of course, pertained to the claims of the international application (specifically, claim 5 concerning Japanese document 7-175725 and claim 1-5 of Japanese document 8-272925).

With regard to this, it is noted that MPEP 609 on page 600-122 of MPEP under the heading A(3) Concise Explanation of Relevance for Non-English Language Information states:

“where the information listed is not in the English language, but was cited in a search report or other action by a foreign patent office and a counterpart foreign application, the requirement for a concise explanation of relevance can be satisfied by submitting an English-language version of the search report or action which indicates the degree of relevance found by the foreign office. This may be an explanation of which portion of the reference is particularly relevant, to which claims it applies, or merely an ‘X,’ ‘Y,’ or ‘A’ indication on a search report.”

In the present instance, the International Search Report clearly indicated the letter “Y” designation of relevance, thereby meeting the requirements for a concise explanation under the provisions of MPEP 609. Accordingly, reconsideration of the

two documents in question and listing of these documents with the next Office Action is respectfully requested.

Reconsideration and removal of the 35 U.S.C. 102(e) rejection of claims 1 and 2 as being anticipated by Gafken (USP 6,026,016) is respectfully requested. With regard to claim 1, in order to emphasize the features discussed above for the present invention, the last paragraph of the claim has been amended to read:

“wherein the non-volatile semiconductor memory is divided into plural areas wherein a first one of said plural areas is read, written or erased by the host computer through first commands and a second one of said plural areas is read, written or erased by the host computer through second commands which are different from said first commands.”

Reading this (solely for purposes of example) on Fig. 3 of the Specification, it can be seen that claim 1 defines an arrangement in which the non-volatile semiconductor memory is divided into plural areas (e.g., the normal area of user data 1711 and the protected area of user data 1712) shown in Fig. 3). Beyond this, claim 1 clearly defines that a first one of the plural areas (e.g. the “normal area”) is read, written or erased by the host computer through first commands whereas the second one of the plural areas (e.g. the “protected area”) is read, written or erased by the host computer through second commands which are different from said first commands.

It is respectfully submitted that Gafken fails to teach or suggest these claimed features. In Gafken, Figs. 1 and 3 illustrate memory arrays 130 that are, in fact, divided into plural areas. The locking and unlocking of each of these areas is controlled by a locking circuit 140. As such, Gafken is of general interest in that it does teach dividing a memory into plural areas which can be locked or unlocked independently of other areas. Notwithstanding this, Gafken fails to teach or suggest an arrangement in which a first area is read, written or erased by using first

commands which are different than second commands used for reading, writing or erasing a second area of the memory. Further, nothing in Gafken suggests modification of their system to change their locking/unlocking arrangement to the different arrangements specified by claim 1. Therefore, reconsideration and allowance of claim 1, as amended, is respectfully requested.

With regard to dependent claim 2, in addition to containing the distinguishing features for its parent claim 1 discussed above, claim 2 has been amended to clearly specify that the external storage device dynamically changes the sizes of the first and second areas based on an instruction of the host computer by a part which rewrites the information indicative of the plural areas of the non-volatile semiconductor memory. It is respectfully submitted that nothing in the Gafken reference teaches or suggests such an arrangement in which the size of each of the blocks itself is changed on the basis of an instruction of the host computer. Therefore, reconsideration and allowance of amended claim 2 is also respectfully requested.

Consideration and allowance of newly submitted claims 6-8 provided with the May 29, 2002 Supplemental Response and newly submitted claims 9-16 is also respectfully submitted. New claims 6-8 are particularly directed to features concerning the protected and non-protected data areas (such as shown in Fig. 3) which were, in fact, specified in non-elected claims 3-5. However, claims 6-8 define these features in terms of dependent claims which are dependent on the elected claims 1 and 2. As such, claims 6-9 serve to further define the plural areas set forth in claims 1 and 2 in the more specific terms of protected and non-protected data areas. Examination and allowance of these new dependent claims 6-8 is, correspondingly, requested both in terms of their allowability based on incorporating

the subject matter of their elected parent claim 1 as well as for their own further distinguishing features of specifying the protected and non-protected data areas and the authentication procedure (in the case of claims 6 and 7) or the additional feature of recognizing the host computer during activation and performing access to the plural areas based on the recognized kind of host computer. It is respectfully submitted that Gafken clearly fails to teach or suggest not only the features of the elected parent claim 1, but also these additional features defined in claims 6-8.

Similarly, consideration and allowance of newly presented claims 9-16 is also respectfully requested. These dependent claims further define their parent claim 1 by defining the first and second areas of claim 1 in terms of a normal area and a protected area, such as shown in Fig. 3. In addition, these claims include the feature of the management data area shown in Fig. 3, and the operation of this management data area in conjunction with the part for controlling the non-volatile semiconductor memory defined in parent claim 1. Again, it is respectfully submitted that Gafken fails to teach or suggest these additional features set forth in claims 9-16, and consideration and allowance of these claims is also respectfully requested.

For the reasons set forth above, it is respectfully submitted that all of claims 1, 2 and 6-16 are in condition for allowance, and such action is respectfully requested.

Attached hereto is a marked-up version of the changes made to the claims by the current amendment. The attached page is captioned "Version with markings to show changes made."

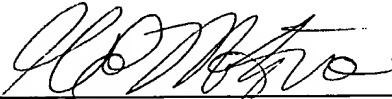
If the Examiner believes that there are any other points which may be clarified or otherwise disposed of, either by telephone discussion or by personal interview, the Examiner is invited to contact applicants' undersigned attorney at the number indicated below.

To the extent necessary, the applicants petition for an extension of time under 37 CFR 1.136. Please charge any shortage in the fees due in connection with the filing of this paper, including extension of time fees, to the deposit account of Antonelli, Terry, Stout & Kraus, Deposit Account No. 01-2135 (566.38877X00)

Respectfully submitted,

ANTONELLI, TERRY, STOUT & KRAUS, LLP

By



Gregory E. Montone  
Registration No. 28,141

GEM/kd  
703/312-6600

VERSION WITH MARKINGS TO SHOW CHANGES MADE

In the Claims:

Claims 1 and 2 have been amended as follows:

1. (Amended) An external storage device connectable to a host computer, comprising:

- a non-volatile semiconductor memory;
- a part for connecting to the host computer; and
- a part for controlling the non-volatile semiconductor memory.

wherein the non-volatile semiconductor memory [including] is divided into plural areas [to be] wherein a first one of said plural areas is read, written or erased by the host computer through [plural different] first commands and a second one of said plural areas is read, written or erased by the host computer through second commands which are different from said first commands.

2. (Amended) An external storage device according to claim 1, further comprising information indicative of the plural areas of the non-volatile semiconductor memory,

the external storage device dynamically changing the sizes of the first and second [plural] areas of the non-volatile semiconductor memory on the basis of an instruction of the host computer by a part which rewrites the information indicating of the plural areas of the non-volatile semiconductor memory.

New claims 9-16 have been added.